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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TRAN, NGHI V

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,160

Applicant(s)

HAMILTON ET AL.

Examiner

Nghi V Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/7/02; 6/9/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 15-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claims 1-14 and 22-27, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 28, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Quine, U.S. Patent No. 6,782,415.
4. With respect to claim 1, Quine teaches a system for correcting the failed delivery of electronic documents [see abstract and figs.1-4], said system comprising:

- a document system [120 i.e. “complete company communications system”], said document system producing document data [col.4, Ins.30-38] and document print requests for printing documents [col.5, Ins.45-50];
- a print management system [150 and 160], wherein said print management system accepts document data and document print requests from said document system, and further wherein said print management system determines whether a requested document is designated for electronic delivery or non-electronic delivery based on a stored document delivery designation [col.5, Ins.45-65];
- a recipient database [130 i.e. “database system”], wherein said recipient database stores document recipient information [col.4, Ins.38-67]; and
- a failed email management system [140 i.e. “control and reporting”], wherein said failed email management system is configured and arranged to receive a notice of a failed email delivery including a failed email address, and to change a document delivery designation for at least the intended recipient of the failed email [col.5, Ins.45-65 and col.6, Ins.23-60].

5. With respect to claim 2, Quine further teaches said failed email management system extracts identifying email data fields [fig.4 and col.6, Ins.11-21 i.e. “user preferences registered in the database system”] from said notice of a failed email delivery [col.5, Ins.55-59] and retrieves alternate contact information from the recipient database based on the extracted identifying email data fields [col.8, Ins.33-67].

6. With respect to claim 3, Quine further teaches said alternate contact information [col.8, ln.44] includes at least: a customer name; a telephone number; or a mailing address [col.8, lns.45-67 i.e. "a mailing address" is interpreted as "hard copy"].

7. With respect to claim 4, Quine further teaches said failed email management system further comprises an Internet server, wherein said Internet server provides access for the intended recipient of the failed email delivery to correct said failed email address [fig.1].

8. With respect to claim 22, Quine teaches in a document delivery system comprising a storage element for storing document delivery preferences for document recipients, a failed email system comprising:

- a first server [210 i.e. "complete company communication system"], said first server configured to receive a failed email notice [115 i.e. "closed loop tracking"], wherein, upon receipt of a failed email notice, said first server initiates a change in a document delivery preference for the intended recipient of the failed email [col.5, lns.45-65 and col.6, lns.23-60];
- a processing element, wherein said processing element is configured to extract identifying data from said failed email notice and to retrieve alternate contact information for the intended recipient of the failed email [col.8, lns.33-67].

9. With respect to claim 23, Quine further teaches the failed email system further comprises a recipient database [130], said recipient database configured to store recipient contact information [col.4, Ins.37-67].

10. With respect to claim 24, Quine further teaches said document delivery preferences include at least the preference to receive documents electronically or non-electronically [fig.1].

11. With respect to claim 25, Quine further teaches said alternate contact information [col.8, ln.44] includes at least one of: a customer name; a telephone number; and a mailing address [col.8, Ins.45-67 i.e. "a mailing address" is interpreted as "hard copy"].

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5-14 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quine as applied to claims 1 and 22 above, and further in view of Mayle et al., U.S. Patent No. 6,542,936 (hereinafter Mayle).

14. With respect to claims 5 and 26-27, Quine is silent on said failed email management system further comprises a postcard form template accessible via the Internet, wherein the intended recipient of the failed email delivery may print the postcard form template, provide information requested on the postcard form template and mail the postcard form template back for processing.

However, Quine clearly teaches said failed email management system further comprises an employee data entry and registration interface [500] accessible via the Internet [fig.4].

In a communication system, Mayle discloses a system for creation of an image display such as an electronic postcard [see abstract].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Quine in view of Mayle by adding a system for creation of an electronic postcard because this feature is fully customizable, the closed-loop multimedia message delivery system can be advantageously implemented and applied to any organization or operation wherein message or document delivery is performed [Quine, col.8, lns.63-67]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Quine in view of Mayle in order to focus follow-up messages on employees who have not responded to a message or notification [Quine, col.8, lns.8-11].

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15. With respect to claim 6, Quine further teaches said system further comprises a consent database [130], said consent database storing each potential document recipient's selected document delivery designation to receive documents electronically or non-electronically [col.4, Ins.38-67 and col.5, Ins.45-67].

16. With respect to claim 7, Quine further teaches said print management system determines whether to process a document for electronic on non-electronic delivery [150 i.e. account for hard copy] based upon the document delivery designation stored in said consent database [col.5, Ins.45-67].

17. With respect to claim 8, Quine further teaches said system further comprises a parsing engine [120], wherein said parsing engine receives document data from said print management system for documents selected for electronic delivery, and further wherein said parsing engine processes said document data for storage [col.4, ln.30 - col.5, ln.19].

18. With respect to claim 9, Quine further teaches said system further comprises a server [i.e. secure/standard e-mail], wherein said server provides on-line access to the document data and electronic documents stored by said parsing engine [col.5, Ins.20-25].

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19. With respect to claim 10, Quine further teaches said email system composes and transmits electronic notices regarding the status and availability of stored documents and document data [fig.2].

20. With respect to claim 11, Quine further teaches said email system composes electronic documents comprised of document data and transmits said electronic documents to electronic document recipients [fig.2 i.e. email].

21. With respect to claim 12, Quine further teaches said email system combines multiple electronic notices [i.e. "eliminates delivery of multiple messages that are duplicates"] for delivery to a single recipient at one time [col.6, Ins.23-51].

22. With respect to claim 13, Quine further teaches said email system combines multiple electronic documents [i.e. "eliminates delivery of multiple documents that are duplicates"] for delivery to a single recipient at one time [col.6, Ins.23-51].

23. With respect to claim 14, Quine further teaches the document delivery designations for multiple recipients are changed together based upon common identifying criteria [col.7, Ins.32-64].

Conclusion

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24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. "Method and apparatus for controlling dead e-mail address scanning discovery, status retries, and other metric to enforce e-mail quality of service," by Kubik et al., U.S. Patent No. 6,829,636.

b. "Systems and methods for automatically forwarding electronic mail when the recipient is otherwise unknown," by Reilly, U.S. Patent No. 6,427,164.

c. "Method and system for form processing," by Bruce et al., U.S. Patent No. 6,741,724.

d. "System and method for electronic and physical mass mailing," by DANIELS et al., U.S. Patent Application Publication No. 2001/0014164.

e. "Task management," by Thompson et al., U.S. Patent Application Publication No. 2001/0007976.

f. "Method and apparatus for managing communication information collectively in communication terminal device," by Wakasugi et al., U.S. Patent No. 6,823,367.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi V Tran
Patent Examiner
Art Unit 2151

NT


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SUPERVISORY PATENT EXAMINER